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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,296	05/30/2001	Tatsushi Nashida	450100-03302	7330

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FROMMER LAWRENCE & HAUG  
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NEW YORK, NY 10151

EXAMINER
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HOSSAIN, FARZANA E

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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04/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/870,296	<b>Applicant(s)</b> NASHIDA ET AL.	
	<b>Examiner</b> FARZANA E. HOSSAIN	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/24/2008 has been entered.

### ***Response to Amendment***

2. This office action is in response to communications filed 03/24/2008. Claims 1-6, 8 and 9 are pending. Claims 1, 4, 8 and 9 are amended. Claims 2, 3, 5 and 6 have been previously presented. Claim 7 is cancelled.

### ***Response to Arguments***

3. Applicant's arguments filed 03/24/2008 have been fully considered but they are not persuasive.

Regarding Claims 1 and 4, the applicant argues that Kuroda discloses warning a user and that Kuroda does not teach or suggest issuing a recoding substitution request

to an external device only allows a viewer to select another storage device (Pages 9-12). The applicant argues that Zigmond does not disclose the claim limitations of the one inserting or substitution advertising information in a recorded program stored in a storage means.

In response to the argument, the examiner respectfully disagrees. As the applicant pointed out, the viewer may select another or external device. Kuroda discloses means for issuing a recording substitution request to an external device for recording the program via the connection means in response to a negative result of the determination or based on the determination of insufficient capacity, the recording system processes another recording request or recording substitution request to an external device or VCR or DVD or other peripheral device (Column 4, lines 38-57, Figure 7). Furthermore, the device with insufficient capacity is deleted (Figure 7). Kuroda meets the limitations as disclosed in the claims. Zigmond discloses inserting the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program without regard to the channel included in the recorded program and also some not all commercials or advertisements are overwritten based on timewise data (Column 12, lines 54-59, Column 14, lines 1-12) or replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12). Also, Zigmond discloses that one advertisement can be replaced versus all the advertisements (Figures 2A, 2B).

In response to the arguments for dependent claims for claims 1 and 4, see response to the arguments for claim 1.

Regarding Claim 3, the applicant argues that the Office has not indicated how a failure in a system will result in determining that it is impossible to record. The rejection of official notice has been removed.

In response to the argument, Kuroda discloses the determination means generates a negative result when a failure in the system prevents a broadcast program from being recorded in the storage means or insufficient capacity of a storage device making it impossible to store in the device (Figure 7).

4. In response to the arguments, claim 8 is a broader limitation than claim 1, 4 and 9. There are no claim limitations for insertion of advertisements.

The applicant argues that Chihara does not disclose automatically issuing a recording substitution request (Page 8).

In response to the argument, the claim does not disclose the applicant's arguments. Chihara meets the limitations as disclosed in the claims.

Note: there is a new rejection for Claim 8 as anticipated by Kuroda.

5. Applicant's arguments with respect to claim 9 have been considered but are moot in view of the new ground(s) of rejection.

See arguments to Claim 1.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Chihara (US 6,678,462).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding Claim 8, Chihara discloses a recording system for recording and/or reserving a program and a recording substitution system for substitutionally recording a program (Figure 4) comprising:

A request accepting portion configured to accept a request to record and/or reserve a program (Figure 3, S2, S3, S4, S6, Figure 4);

A storage portion configured to record a program (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4);

A connection portion configured to connect with an external device or a connection means to another storage device (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4, Figure 1);

A determination portion configured to determine whether the storage portion contains sufficient space to record a program requested to be recorded an/or reserved (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4) and

An issue portion configured to issue a recording substitution request to the external device via the connection portion automatically in response to negative result from the determination portion (Column 5, lines 48-57, Column 6, lines 15-24, Figure 4).

8. Claim 8 is rejected under 35 under 35 U.S.C. 102(e) as being anticipated by Kuroda (US 6,311,011).

Regarding Claims 8, Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1), comprising: a request accepting portion configured to accept a request to record and/or reserve a program (Column 4, lines 18-50); a storage portion configured to record a program (Column 4, lines 18-50, Figure 2, 103, 105); connection portion for connecting with an external device (Column 4, lines 38-44,

Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2) determination portion to determine the storage portion contains sufficient space to record a program requested to recorded and/or reserved (Column 5, lines 60-65); an issue portion configured to issue a recording substitution request to an external device for recording the program via the connection means in response to a negative result of the determination (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recoding system or recording substitution system receives and records television programs in the storage means or the external device.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda (US 6,311,011) in view of Zigmond et al (US 6,698,020 and hereafter referred to as "Zigmond").

Regarding Claims 1 and 4, Kuroda disclose a recording system for recording and/or reserving a program (Figure 1) and a recording substitution system for substitutionally recording a program (Figure 1), comprising: means for accepting a request to record and/or reserve a program (Column 4, lines 18-50); storage means for recording a program (Column 4, lines 18-50, Figure 2, 103, 105); connection means for connecting with an external device (Column 4, lines 38-44, Column 5, lines 60-65); means for receiving a program (Figure 1, Figure 2) determination means for determination whether it is possible to record a program requested to recorded and/or reserved (Column 5, lines 60-65); means for issuing a recording substitution request to an external device for recording the program via the connection means in response to a negative result of the determination (Figure 22, Figure 7). Kuroda discloses recording substitution means or the recorder/player for responding to reception of a recording substitution request via connection means and receiving and recording a corresponding in the storage means (Column 5, lines 60-65, Figure 7). Kuroda discloses the recoding system or recording substitution system receives and records television programs in the storage means or the external device, which necessarily includes commercials. Kuroda is silent on user information management means for storing user information about each requesting origin, and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means and one of a) inserts the advertising information in a recorded program stored in the storage means in addition to original commercial information included in the recorded program and b) substitutes the advertising information for the original information in the recorded program.

Zigmond discloses user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the information in a recorded program or the household device or advertisement insertion device has a connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute is inserted into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65). Zigmond discloses one of a) inserting the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program and only some commercials have to be replaced in a recorded program so inserting new commercials to original commercials with the recorded program (Column 14, lines 1-12, Column 12, lines 54-59) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include that the user information management means for storing user information about each requesting origin (Figure 5, 82), and obtaining advertising information appropriate for a user attribute of the requesting origin via the connection means to the external device and inserting the

Art Unit: 2623

information in a recorded program or the household device or advertisement insertion device has a connection means to external devices including video tape or any other medium carrying recorded video programming which has the stored video program and advertisements appropriate for a user attribute and one of a) inserting into the recorded program (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program included in the recorded program some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12, Column 12, lines 54-9) and b) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12 as taught by Zigmond in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Regarding Claim 9, Kuroda disclose a recording substitution system for substitutionally recording a program (Figure 1), comprising:

a receiving portion configured to receive a program (Figure 1, 102), storage portion configured to record a program (Column 4, lines 18-50, Figure 2, 103, 105); connection portion for connecting with an external device (Column 4, lines 38-44, Column 5, lines 60-65); recording substitution portion configured to (a) respond to reception of recording substitution request from the connection portion (Figure 7, S105-S107), b) receive and record a correspond program in the storage portion (Figure 7, S101). It is necessarily included that a program includes commercials. Kuroda is silent

Art Unit: 2623

on one of 1) substitutes the advertising information for the original information in the recorded program and 2) inserts additional advertising information in a recorded program stored in the storage means in addition to original commercial information included in the recorded program. Zigmond discloses a program comprising advertisements or commercials (Figure 5, Figure 6, Column 7, lines 9-12, Column 11, lines 31-65) and recording substitution portion (Figure 5) configured to one of 1) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12) and 2) inserting the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program and only some commercials have to be replaced in a recorded program so inserting new commercials to original commercials with the recorded program (Column 14, lines 1-12, Column 12, lines 54-59) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kuroda to include one of 1) replacing or substituting for the original commercial information included in the recorded program (Column 14, lines 1-12) and 2) inserting the advertising information in a recorded program in addition to original commercial information or any commercials that an advertiser can specify to be shown during a particular program and only some commercials have to be replaced in a recorded program so inserting new commercials

Art Unit: 2623

to original commercials with the recorded program (Column 14, lines 1-12, Column 12, lines 54-59) included in the recorded program interpreted which is met by some commercials or advertisements are overwritten based on timewise data (Column 14, lines 1-12) as taught by Zigmond in order to provide advertisements that are more interesting to the viewer for premium payment from the advertiser (Column 1, lines 23-35) as disclosed by Zigmond.

Regarding Claim 2, Kuroda and Zigmond disclose all the limitations of Claim 1. Kuroda discloses the determination means generates a negative result when a remaining capacity of the storage means is not sufficient for recording a broadcast program requested to be recorded and/or reserved (Figure 7, Column 5, lines 60-65).

Regarding Claim 3, Kuroda and Zigmond disclose all the limitations of Claim 1. Kuroda discloses the determination means generates a negative result when a failure in the system prevents a broadcast program from being recorded in the storage means or insufficient capacity of a storage device making it impossible to store in the device (Figure 7).

Regarding Claim 5, Kuroda and Zigmond disclose all the limitations of Claim 4. Kuroda discloses when the recorder is connected with the Internet; the video recorder may store signals via World Wide Web in the temporary storage device (Column 12, lines 28-44). It is noted that the World Wide Web records data from a plurality of external devices (plurality of users) and the substitution means is located upstream from the user and records program per users requests.

Regarding Claim 6, Kuroda and Zigmond disclose all the limitations of Claim 4. Kuroda discloses comprising user information management means for storing user information about each requesting origin, wherein the recording substitution means records a broadcast program in a format appropriate for a user attribute of the requesting origin including HDD format, DVD format or VCR format (Figure 1, 105, Figure 7, Figure 22).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA E. HOSSAIN whose telephone number is (571)272-5943. The examiner can normally be reached on Monday to Friday 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/  
Supervisory Patent Examiner, Art  
Unit 2623

FEH  
April 21, 2008